REMARKS

Claims 69-96 were pending in the subject application. Claims 71, 73, 77, 79, 81-93 and 95-96 have been canceled. Claims 69-70 and 72, 74 and 94 have been amended to clarify the claimed subject matter. By this amendment, claims 69-70, 72, 74-76, 78, 80 and 94 are now pending in the subject application.

Claims 69-70, 72 and 74 have been amended to delete the phrase "prodrug, hydrate or solvate." Support for the amendment to claims 69-70, 72 and 74 can be found, for example, in original claims 69-70, 72 and 74, respectively.

Claims 69 and 70 have also been amended to delete the compounds "1-{2-[5-(3-morpholin-4-yl-propoxy)-benzoimidazol-1-yl]-quinolin-8-yl}-piperidin-4-ylamine" and "1-[2-(5-isobutoxy-benzoimidazol-1-yl)-quinolin-8-yl]-piperidin-4-ylamine."

Claim 94 has been amended to delete the phrase "for the treatment of abnormal cell growth in a mammal" from the preamble of the claim. Support for this amendment can be found in the original specification at, for example, page 1, lines 3-6 and in original claim 94.

No new matter has been added. Entry of this Amendment is respectfully requested.

I. Rejection of Claims 69-80 and 94-96 under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 69-80 and 94-96 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. In particular, the Examiner asserts that "[t]he specification does not provide written description for prodrugs, hydrates or solvates as is instantly claimed."

Claims 71, 73, 77, 79 and 95-96 have been deleted, thereby rendering the Examiner's rejection of those claims moot.

Claims 69-70, 72 and 74 have been amended to delete the terms "prodrugs," "hydrates" and "solvates." Claims 75-76, 78 and 80 depend directly upon amended claims 69-70, 72 and 74, respectively, and claim 94 depends upon amended claim 69. Applicants respectfully submit that the above amendment to claims 69-70, and 72-74 have fully addressed the Examiner's rejection of claims 69-70, 72, 74-76, 78, 80 and 94 (claims 71, 73, 77, 79 and 95-96 having been canceled) as allegedly failing to comply with the written description requirement. Accordingly, Applicants request that the rejection of claims 69-70, 72, 74-76, 78, 80 and 94 under 35 U.S.C. § 112, first paragraph be withdrawn.

II. Rejection of Claims 81-93 under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 81-93 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. In particular, the Examiner asserts that "[t]he instant specification does not adequately describe the nexus between the modulation of the tyrosine kinase receptor and a useful treatment of a disease condition." In order to expedite the allowance of this case, Applicants have canceled claims 81-93, thereby rendering the Examiner's rejection of those claims moot.

III. Rejection of Claims 81-93 under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 81-93 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written enablement requirement. In particular, the Examiner asserts that "the specification fails to provide sufficient support of the broad use of the compounds of claim 69 for the treatment of a cancer/disease. As a result necessitating one of ordinary skill to perform an exhaustive search for which disease can be treated by which compound of claim 1 in order to practice the claimed invention." The Examiner contends that "to practice the claimed invention herein, one of ordinary skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compounds of the instant claims, with no assurance of success." In order to expedite the allowance of this case, Applicants have canceled claims 81-93, thereby rendering the Examiner's rejection of those claims moot.

IV. Rejection of Claims 69-96 under 35 U.S.C. § 103(a)

The Examiner rejected claims 68-96 under 35 U.S.C. § 103(a) as being allegedly unpatentable over International Publication No. WO 01/40217 ("the '217 publication") for the reasons set forth in the Office Action. In particular, the Examiner asserts that "[t]he difference between the instant claims and the compounds of WO is that the WO teaches a generic structure and smaller generic markushes that encompasses the instant compounds but does not have a specific example that anticipates the instant claims." The Examiner asserts that "[t]he Markush taught by the WO is small and the examples lack only the specific 5-benzimidazol [sic] position substitutents. All other substituents have examples from the WO." The Examiner contends that "it would have been obvious to one of ordinary skill in the art to make the compounds of the instant claims from the generic and specific teachings of the WO with the reasonable expectation of getting compounds having activity for inhibiting tyrosine kinase." Applicants respectfully

traverse this rejection.

The amended claims of the present application are directed to 1-[2-(benzimidazol-1-yl)quinolin-8-yl]-piperidin-4-ylamines where the 5-position of the benzimidazole core is substituted by a -tetrahydrofuran-3-yloxy, -3-methyl-oxetan-3-ylmethoxy or -tetrahydro-pyran-4-yloxy group. In contrast, the '217 publication relates to a broad genus of compounds including compounds where quinolinyl group and the benzimidazolyl group can be substituted with a wide variety of groups (see page 2, lines 19-30 and page 3, lines 35-35 of the '217 publication). Moreover, the genus described in the '217 publication also includes compounds where the carbon atom at the 8-position of the benzimidazolyl group is replaced by a nitrogen atom. However, the '217 publication does disclose any 2-(benzimidazol-1-yl)quinolinyl compound where the 5-position of the benzimidazole ring is substituted by a -cycloalkoxy or -alkyl(cycloalkoxy) group. Nor does the '217 publication provide any teaching or suggestion to modify the disclosed structures and prepare a 2-(benzimidazol-1-yl)quinolinyl compound where the 8-position of the quinolinyl group is substituted by a -piperidyn-4ylamine **and** the 5-position of the benzimidazole ring is substituted a -cycloalkoxy or -alkyl(cycloalkoxy) group.

Where an obviousness rejection is made over a prior art class encompassing, but not disclosing, a claimed compound, the prior art must provide a suggestion to one of ordinary skill in the art to select the specific variables from the disclosed generic formula and thereby arrive at the claimed compound. *In re Baird*, 16 F.3d 380, 382-383 (Fed. Cir. 1994). Characterization of a claimed compound as "similar" or "slightly different" from compounds taught in the prior art does not establish the obviousness of the use of compound that is new and nonobvious, since the mere chemical possibility that a prior art compound could be modified or does support a finding of obviousness unless the prior art suggested the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570 (Fed. Cir. 1995).

As discussed above, the '217 publication does not teach or suggest modifying the disclosed 2-(benzimidazol-1-yl)quinolinyl compounds and thereby arrive at a compound where the 8-position of the quinolinyl group is substituted by a -piperidinyl-4-ylamine group **and** the 5-position of the benzimidazole ring is substituted a –cycloalkoxy or -alkyl(cycloalkoxy) group. And because the '217 publication does not teach or suggest a 1-[2-(benzimidazol-1-yl)quinolin-8-yl]-piperidin-4-ylamine where the 5-position of the benzimidazole core is substituted by a -cycloalkoxy or -alkyl(cycloalkoxy) group, one of ordinary skill in the art would find no

suggestion to modify the disclosed structures and thereby arrive at a -[2-(benzimidazol-1-yl)quinolin-8-yl]-piperidin-4-ylamine where the 5-position of the benzimidazole core is substituted by a -tetrahydrofuran-3-yloxy, -3-methyl-oxetan-3-ylmethoxy or -tetrahydro-pyran-4-yloxy group as recited in the claims of the subject application. Therefore, claims 69-70, 72, 74-76, 78, 80 and 94-95 of the subject application are not obvious over the '217 publication as required by *In re Baird* and *In re Ochiai*.

In view of the above, Applicants respectfully submit that claims 69-70, 72, 74-76, 78, 80 and 94 (claims 71, 73, 77, 79, 81-93 and 95-96 having been canceled) are not obvious over the '217 publication, and request that the rejection of claims 69-70, 72, 74-76, 78, 80 and 94 under 35 U.S.C § 103(a) be withdrawn.

CONCLUSION

Applicants respectfully request prompt consideration of the pending claims and early allowance of the application. No additional fee is believed due. However, if any fee is due, the Examiner is authorized to charge the fee to Applicants' Deposit Account No. 16-1445.

If the Examiner wishes to comment or discuss any aspect of this application or response, Applicants' undersigned agent invites the Examiner to call him at the telephone number provided below.

Respectfully submitted,

Date: February 2, 2006

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